

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Oliver SCHADT et al.

Examiner: GRAZIER, Nyeemah

Serial No.: 10/511,155

Group Art Unit: 1626

Filed: OCTOBER 14, 2004

Confirmation No.: 9151

Title: **SUBSTITUTED INDOLES**

PETITION UNDER 37 CFR §1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

It is respectfully requested that the Commissioner, through the honorable group Director, overturn the requirement for restriction mailed January 25, 2006. The requirement for restriction was made final in the Office Action mailed May 8, 2006. Inasmuch as a Notice of Appeal with a 2nd-Month Extension of Time is being filed concurrently with this Petition, this petition is considered timely.

STATEMENT OF FACTS

The requirement for restriction mailed January 25, 2006, divides the application into a non-exhaustive list of ten groups. Groups I through VIII all encompass Claims 1-16, but set forth different definitions of the various groups therein.

In response to the requirement for restriction, applicants elected Group VIII, wherein:

R¹, A, D-E, Het, Ar, Hal, w, n, g and m are recited in Claim 1;

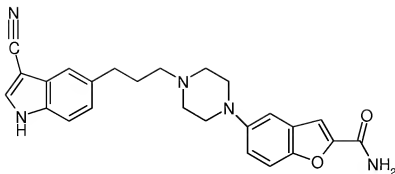
X¹ is (CHR7)g;

E and G together form a saturated 1,4-diazine ring wherein the additional nitrogen is linked directly to variable Z;

X² is a bond; and

Z is a benzofuranyl ring.

As a species, applicants elected the compound:



In partial compliance with MPEP §803.02, after the elected species was searched and no prior art found, the search was extended to include embodiments of the invention wherein Z was an aromatic heterocyclic polycyclic ring system having 4 to 9 carbon atoms and wherein the aromatic heterocyclic system contained 1 to 4 heteroatoms which are, independently, nitrogen, oxygen and sulfur, thus bringing in elements of groups I-VII. The requirement for restriction has been continually traversed by applicants.

Claims 20, 21 and 22 were added in applicant's response of October 10, 2006. Claims 21 and 22 are dependent upon Claim 20. Claims 20 and 22 were held to be withdrawn, in the Office Action mailed January 19, 2007, as evidenced from item number 4 of page 2 of the Office Action.

RELIEF REQUESTED

It is respectfully requested that:

1. Withdrawn Claims 20 and 22 be rejoined for consideration and examination;
- and
2. The requirement for restriction be withdrawn, in its entirety.

Claims 20 and 22

Claims 20 and 22 have been incorrectly grouped with the withdrawn claims. No discussion of why these claims were withdrawn is found in the Office Action. It is respectfully submitted that Claims 20 and 22 fall within the elected group. As in the elected group, Claim 20 recites that D-E is $R^2C=CR_4$, X^1 is $(CHR^7)_n$, X^2 is a bond, and Z can be a variety of structures including the previously elected benzofuran. Similar definitions are

encompassed for Claim 22. Thus, these claims clearly fall within the elected group, and should not be withdrawn. It is respectfully requested that the restriction requirement be directed to be withdrawn as it respects these claims.

Requirement in its Entirety

In addition, it is submitted that the restriction requirement as a whole has no basis, and should be withdrawn. The various Office Actions touching on the restriction requirement characterize the elected compound as having, as a "special technical feature, a fused benzene ring." First, it is submitted that, for the Markush Practice situation, the administrative instructions do *not* require that patentability be based on the "special technical feature." The rules require only "common structure" or belonging to a "recognized class" of compounds. The only mention of novelty is the notation that, if it can be shown that at least one Markush alternative is not novel over the prior art, the question of unity of invention "shall be reconsidered." The instructions then state that reconsideration does not necessarily imply that an objection of lack of unity shall be raised. It is thus evident that patentability over the art is *not* required in the Markush situation to establish unity of invention. Rather, the special technical feature need only possess common structure and a common property or activity. Common structure is evident, as noted in the Office Action, from the claims. Common properties are evident in that, as stated in the specification, the compounds have action on the central nervous system. All of the claim compounds have the benzene fused ring, *and in addition*, a chain off the benzene portion of the ring, which may contain a heteroatom, and additional ring structure formed from E and G, on an optional basis. It is not seen why the *entirety* of the structure is not being considered by the examiner, but it is submitted that the structure as a whole presents the "special technical feature" and that unity of invention is satisfied.

Accordingly, it is submitted that ample basis to overturn the requirement for restriction exists, and the same is respectfully requested.

Payment for the Notice of Appeal, with the 2nd-Month Extension of Time, is being paid through EFS and no other fees are believed to be due. However, the Commissioner is

hereby authorized to charge any additional fees associated with this response to Deposit
Account No. 13-3402.

Respectfully submitted,

/Harry B. Shubin/
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